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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,450	04/19/2004	Michael Norvise	PA 104-04	1045
27587	7590	08/19/2005	EXAMINER	
LEONARD WEISS 2300 W. SAHARA AVENUE, BOX 34 LAS VEGAS, NV 89102			PASSANITI, SEBASTIANO	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/826,450

Applicant(s)

NORVISE, MICHAEL

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 and 4-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 and 4-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office action is responsive to communication received 05/09/2005 –
Amendment.

Claims 1 and 3 have been canceled, as directed.

Claims 2 and 4-9 remain pending.

Following is an action on the MERITS:

Specification

The amendment filed 05/09/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendment introduces language beginning at page 5, line 4 and continuing through page 5, line 13 that details the fin as being made of metal as well as having the general shape of a fin of a fish. Moreover, the newly added language details that the bottom edge of the fin extends along a centerline of the body.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112 – 1st and 2nd Paragraphs

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 2 and 4-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In this case, applicant's amendments to the claims present new matter. **This is a new matter rejection.** Specifically, the introduction of language detailing the sighting fin having the general shape of a fin of a fish and further having a bottom edge that extends along the centerline of the body is deemed to be new matter. Further the language detailing the metal body being symmetrical about a centerline between a heel and a toe of the body is deemed to be new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 4-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Under §112, second paragraph, the claim language must accurately define the invention. See *In re Knowlton*, 481 F.2d 1357, 178 USPQ 486 (CCPA 1973).

However, specific to claim 9, the language details that a bottom edge of the fin extends along a centerline of the body to a location rearward of the body from a region of a boundary between the plate and the body. This would appear to be inaccurate, as the

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drawings and the specification clearly show that the bottom edge (39) does not extend beyond the rearward wall (28) of the club head body. The dependent claims, namely claims 2 and 4-8 share the indefiniteness of claim 9. Moreover, the language "shape of a fin of a fish" is not understood. There is no definition provided to definitively set forth the shape of a fin of a fish as it is to be interpreted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4, 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benson ('544) in view of McCabe (of record), Micciche (of record) and Hockerson (of record). The patent to Benson shows every feature claimed except for a plate fixedly connected to the front face, the plate being a hard rubber plate. Both Micciche and Hockerson show it to be old in the art of putter heads to include a supplemental plate device to the front of the striking portion of the head in order to desirably alter the ball striking characteristics of the head. Note that Hockerson intends that a "hard" plate be used, as Hockerson indicates that the ball striking pad (22) is fabricated from a material that has sufficient strength and hardness for providing the desired kinematics feel as compared to conventional putter faces made of metal or other hard materials

(col. 2, lines 40-46). Similarly, Micciche details that the insert (20) includes a striking surface (50) that exhibits a hardness less than the hardness of a golf ball (col. 5, line 65 through col. 6, line 9). Nonetheless, the striking surface (50) is deemed to be "hard". Moreover, the applicant has not provided any description that is useful for determining exactly what the degree of hardness is for the claimed plate. Thus, the usual and customary meaning of the term hard has been adopted here. In addition, Micciche intends that the insert (20) may simply be added to a traditional putter without changing the structure of an existing putter head assembly, thereby making the insert adaptable to fit a variety of putter heads (col. 4, lines 6-15). In view of the patents to Micciche and Hockerson, it would have been obvious to modify the device in the cited art reference to Benson by providing a hard rubber plate to the striking surface as needed, the motivation being to alter the ball striking characteristics of the putter head. Regarding the remaining limitations in claim 9 and with respect to the Benson reference, note that Benson is silent with respect to the material of the head. It is clear that the skilled artisan would have found it obvious at the time of the invention to select any commonly used and available material from which to make the club head based upon the characteristics of the material. Here, **OFFICIAL NOTICE** is taken of the fact that metal is a material commonly used in the golf club making art. Furthermore, at least the prior art to Hockerson obviates the use of metal for a club head body (col. 2, lines 18-21). Specific to claim 4, note that Micciche obviates the inclusion of a separation between the bottom edge of the front face and the bottom edge of the front plate. Regarding the claimed requirement that the fin extend rearward of the head body, note

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that McCabe obviates the inclusion of an alignment fin that protrudes to the rear of the head body. McCabe indicates that a number of diverse configurations may be used, with said configurations clearly falling within the meaning of a "fin", as claimed. Note further that there is some similarity between the alignment structures in McCabe and Benson and that to have modified the Benson device with the teachings gleaned from McCabe simply to provide a variation of the fin design would have been obvious.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benson ('544) in view of McCabe (of record), Micciche (of record), Hockerson (of record) and Morrison (of record). Benson ('544) in view of McCabe, Micciche, and Hockerson has been discussed above. To have further modified the device in Benson to include a curved sole portion to help reduce turf drag would have been obvious in view of the patent to Morrison, which teaches that it is old in the art to include a curved sole to minimize interference with the turf (col. 3, lines 17-24).

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benson ('544) in view of McCabe (of record), Micciche (of record), Hockerson (of record) and Taylor (of record). Benson ('544) in view of McCabe, Micciche and Hockerson has been discussed. Benson, as modified, lacks means for changing weight. Note, Benson does show heel and toe weighting, a feature common to putter-style clubs. However, Benson does not expand on ways to modify the weight of the head. Taylor similarly shows heel and toe ends, but additionally includes threaded weight assemblies to supplement the weighting of the head and to be able to modify the weight, as needed. In view of the patent to Taylor, it would have been obvious to

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modify the Benson device by introducing means for changing the weight of the head, the motivation being to enable the weight distribution to be more customized to a particular golfer.

Drawings

The drawings were received on 05/09/2005. These drawings are acceptable to the examiner for examination purposes only.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheet(s) must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

Timing of Corrections

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Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

Response to Arguments

Applicant's arguments with respect to claims 2 and 4-9 have been considered but are moot in view of the new ground(s) of rejection.

It is noted that should the applicant cancel the new matter introduced into the specification and claims as outlined above, the claims would once again present subject matter that is either anticipated or rendered obvious by the art of record, substantially as the art was applied in the last Office action. In this case, the rejections previously applied to claim 1 would apply to claim 9, in view of the cancellation of claim 1.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sebastiano Passaniti
Primary Examiner

S.Passaniti/sp
August 5, 2005